REMARKS/ARGUMENTS

By this Amendment, no claims are canceled or added. Claims 1-5 and 7-34 are pending.

The Examiner sets forth that Claims 1-2, 7-15, 19-21 and 25-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,370,537 to Gilbert, et al. (hereinafter Gilbert) and U.S. Patent No. 6,654,784 to Wei. Referring to Claim 1, the Examiner sets forth that Gilbert discloses a method for delivering information to a person accessing a banner website from a terminal located remote from a source of the banner web site, the terminal having an associated display upon which a content of the web site is visually perceived by a person using the terminal and a cursor whose position is controllable by the person according to the Examiner. The Examiner directs the Applicants' attention to Col. 17, lines 12-30 which the Examiner believes describe how the banner is determined by an ad server, which is remote from the user's terminal. The Examiner also believes that Fig. 26 shows a web site whose content is visually perceived by the user with banner 2600. According to the Examiner, Col. 17, lines 40-47 describe how the user may move a mouse which controls the position of a cursor.

(a) The Examiner sets forth that the method of Gilbert provides initial signals from the source of the web site or from another remote source when the web site is accessed by the person in order to establish a banner area on the display (Col. 17, lines 12-21), the banner area having banner boundaries (Fig. 26) and including banner advertising information that is visually perceivable by the person when the web site is

accessed and plural sub areas of the banner. The Examiner directs the Applicants' attention to Fig. 26, banner 2600 which the Examiner believes shows three subareas (frames). The Examiner also directs the Applicants' attention to Col. 17, lines 40-44 which the Examiner believes describe how the banner may be split into frames.

(b) The Examiner believes that the method of Gilbert enables the person to control the cursor to position the cursor on any one of the sub-areas of the banner to provide a selected sub-area, whereupon the person is automatically provided with respective additional visually perceivable information associated with the selected sub-area, the additional visually perceivable information being provided without requiring other action by the person, the respective additional visually perceivable information being imperceivable by the person until the cursor is located on the selected sub-area. The Examiner directs the Applicants' attention to Col. 17, lines 44-53, which the Examiner believes describe how a mouse over an image in one of the frames causes a pop-up window (visually perceivable according to the Examiner) to be displayed, which provide additional information associated with the selected sub-area (frame according to the Examiner).

(c) The Examiner believes that the method of Gilbert enables the person to control the cursor to position the cursor on the selected region through the use of the mouse.

(d) According to the Examiner, the respective additional visually perceivable advertising message information of Gilbert is imperceivable by the person until the cursor

is located on the selected subarea. The Examiner directs the Applicants' attention to Col. 17, lines 44-53, which the Examiner believes describe how a mouse over an image in one of the frames causes a pop up window (visually perceivable according to the Examiner) to be displayed, which provides additional information associated with the selected subarea (frame according to the Examiner). According to the Examiner the pop-up window does not have a button in the window for closing the window ("x"), and therefore is believed by the Examiner to remain perceivable to the person as long as the cursor remains on the selected subarea (frame) or on the pop up window. The Examiner believes that it is typical for a mouse over event to last as long as the mouse (cursor according to the Examiner) remains positioned over the image associated with the mouse over. The Examiner takes official notice of this. Therefore, the Examiner believes that it would have been obvious to one of ordinary skill in the art to insure the pop up window of Gilbert remains open as long as the cursor remains on the selected area (frame) or the pop up window (region according to the Examiner), because the lack of movement of this cursor indicates to the Examiner that the user is still reading the additional information. The Applicants respectfully set forth that this is improper judicial notice on the part of the Examiner and that a reference showing such a teaching is required.

The Examiner believes that the instructions for controlling the display of Gilbert (i.e. the banner area with pop up windows) are provided with Java Applets (the Examiner directs the Applicants' attention to Col. 17, lines 12-30). The Examiner therefore sets forth that the instructions are essentially compiled code, compiled code may be achieved

through a vast array of programming environments, including, Java Applets, XML and JavaScript, for example, and the Examiner believes that Gilbert implies but does not explicitly teach that Java may be used to provide the instructions in steps (a) and (b) above. The Examiner believes however that Wei explicitly that Java Applets require starting the Java Virtual Machine and take extra time to download (the Examiner directs the Applicants' attention to Col. 3, lines 29-39 and Col 4, lines 14-25). Wei describes how JavaScript may replace Java Applets to increase performance and reduce the user's wait time (the Examiner directs the Applicants' attention to Col. 4, lines 30-35) according to the Examiner. Thus the Examiner believes that it would have been obvious to one of ordinary skill in the art to modify the advertising method of Gilbert such that the instructions for controlling the display to provide banner advertisements and additional advertisement information are written with JavaScript instead of Java Applets in order to increase performance and reduce wait time as suggested by Wei.

With respect to Claim 2, the Examiner sets forth that Gilbert shows a pop up window associated with banner 26 in Fig. 26, which the Examiner believes substantially crosses the lower boundary of the banner area, but that Gilbert does not explicitly show how the selected region where the pop up window (visually perceivable advertising message information) is displayed substantially outside the boundaries of the banner area. However, the Examiner believes that pop up windows may be placed anywhere within a display and may comprise different sizes. As an example, the Examiner directs the Applicants' attention to Fig. 18 of Gilbert which the Examiner believes shows a pop up

window (1802), disposed substantially outside the boundaries of banner area (1801). Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop up window of Gilbert in a selected region disposed substantially outside of the boundaries of the banner area in order to prevent covering up the banner and reducing its visibility or to enlarge the pop up window to draw attention to it.

Referring to Claims 7-8, the Examiner sets forth that the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable information (pop-up) when in receipt of appropriate date, and that the method of Gilbert re-accesses the source of the website or accesses another source for receiving the data upon which the instructions operate to provide the additional visually perceivable information. The Examiner directs the Applicants' attention to Col. 17, lines 25-31 and 50-54.

With respect to Claim 9, the Examiner sets forth that the pop up window of Gilbert (additional visually perceivable information) is displayed in a selected region (window) of the display adjacent to the selected subarea (frame). The Examiner directs the Applicants' attention to the pop up window over (adjacent) the banner (2600) in Fig. 26.

With respect to Claim 10, the Examiner sets forth that the additional visually perceivable advertising information of Gilbert contains link information for linking the person to a further web site when the person clicks on the selected region. The Examiner directs the Applicants' attention to Col. 17, lines 48-64.

Referring to Claims 11-12, the Examiner sets forth that the method of Gilbert receives the visually perceivable banner information, first identification data representative of the visually perceivable banner information, the additional visually perceivable information, and second identification data representative of additional visually perceivable information. The Examiner believes that Col. 17, lines 25-31 and 50-54, describe how the banner information and additional information are served from an ad server, and therefore must be received by the terminal. According to the Examiner, the method of Gilbert specifies a placement of the additional visually perceivable information with respect to the visually perceivable banner information according to the first and second identification data. The Examiner also believes that Fig. 26 shows the pop-up window (additional information) in relation to the banner.

Referring to Claim 13, the Examiner sets forth that the method of Gilbert must build a use map in accordance with the first and second identification data to associate the appropriate pop-up window with the appropriate image (sub-area) in the banner. The Examiner directs the Applicants' attention to Col. 17, lines 44-47 and to Col. 12, lines 20-28.

Referring to Claim 14, the Examiner sets forth that Gilbert discloses that the step of providing additional visually perceivable information comprises the steps of building a pop-up function in accordance with the additional visually perceivable information (Col. 17, lines 44-47), adding HTML information to the pop-up function to provide an enhanced pop-up function (Col. 17, lines 47-50 and Col. 12, lines 26-28), and displaying the visually

perceivable banner information and the additional perceivable information in accordance with the enhanced pop-up function. The Examiner directs the Applicants' attention to Col. 17, lines 40-50 and the pop-up associated with banner 2600 in Fig. 26.

Referring to Claim 15, the Examiner sets forth that Gilbert discloses the step of altering associations between the sub-area (frames) and the respective additional visually perceivable information and repeating step (b), and the Examiner directs the Applicants' attention to Col. 17, lines 17-31 and 50-54, which the Examiner believes describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

Referring to Claim 19, the Examiner sets forth that Gilbert discloses transmitting a request having request information to a server database (ad server) on a further website containing stored visually perceivable information in response to the positioning of the cursor on the selected sub-area (frame), selecting the additional visual information (pop-up window) from the stored visual information in response to the request information and transmitting the selected stored visual information to the banner website. The Examiner directs the Applicants' attention to Col. 17, lines 44-54.

Referring to Claim 20, the Examiner sets forth that the terminal of Gilbert provides a terminal display having a display iframe comprising the steps of displaying the visually perceivable banner information within the display iframe and displaying the additional visually perceivable information in response to positioning the cursor on the iframe. The Examiner directs the Applicants' attention to Col. 17, lines 12-47 and Fig. 26.

With respect to Claim 21, the Examiner sets forth that Gilbert discloses a system for delivering information to a person accessing a banner web site from a terminal located remote from the source of the banner web site, the terminal having an associated display upon which the content of the web site is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. The Examiner directs the Applicants' attention to Col. 17, lines 12-30 which the Examiner believes describe how the banner is determined by an add server which is remote from the user's terminal. According to the Examiner, Fig. 26 show a web site whose content is visually perceivable by the user with the banner 2600 and Col. 17, lines 44-47 described how the user may move the mouse which controls the position of the cursor.

According to the Examiner, the system of Gilbert provides initial signals from the source of the website or from another remote source when the website is accessed by the person to establish a banner area on the display (the Examiner directs the Applicants' attention to Col. 17, lines 12-21), the banner area including banner information that is visually perceivable by the person when the website is accessed and plural sub-areas of the banner area. The Examiner sets forth that Fig. 26, banner 2600, shows three sub-areas (frames) and that Col. 17, lines 40-44, describe how the banner may be split into frames.

The Examiner further sets forth that the initial signals of Gilbert enable the person to control the cursor to position the cursor on any one of the sub-areas of the banner area to provide a selected sub-area, whereupon the person is automatically provided with

respective additional visually perceivable information associated with the selected sub-area, the additional visually perceivable information being provided without requiring other action by the person, the respective additional visually perceivable information being imperceivable by the person until the cursor is located on the selected sub-area and that Col. 17, lines 44-53, describes how a mouse over an image in one of the frames causes a pop-up widow (visually perceivable) to be displayed, which provides additional information associated with the selected sub-area (frame).

The Examiner believes that Gilbert shows a pop-up window associated with banner 2600 in Fig. 26 which substantially crosses the lower boundary of the banner area, but that Gilbert does not explicitly show that the pop-up window (visually perceivable information) is provided substantially outside the boundaries of the banner area. However, pop-up windows may be placed anywhere within a display and may comprise different sizes according to the Examiner, and as an example, cites Fig. 18 of Gilbert, which the Examiner believes shows a pop-up window (1802), substantially outside of the boundaries of banner (1801). In the Examiner's opinion, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop-up window of Gilbert substantially outside of the boundaries of the banner area, in order to prevent covering up the banner, and reducing its visibility or to enlarge the pop-up window to draw attention to it.

According to the Examiner, the instructions for controlling the display of Gilbert (i.e. the banner area with pop-up windows) are provided through Java Applets (Col. 17, lines 12-30). The Examiner believes that the instructions are essentially compiled code and that

compiled code may be achieved through a vast array programming environments, including Java Applets, XML and JavaScript, for example. Therefore, the Examiner believes that Gilbert implies but does not explicitly teach that JavaScript may be used to provide the instructions in the method above. However, the Examiner believes that Wei explicitly teaches that Java Applets require starting the Java Virtual Machine and take extra time to download (Col. 3, lines 29-39 and Col. 4, lines 14-25). According to the Examiner, Wei describes how JavaScript may replace Java Applets to increase performance and reduce the user's wait time (Col. 4, lines 30-54). Therefore, the Examiner believes it would have been obvious to one of ordinary skill in the art to modify the advertising method of Gilbert such that the instructions for controlling the display to provide banner advertisement and additional advertisement information are written with JavaScript instead of Java Applets in order to increase the performance and reduce wait time as suggested by Wei.

With respect to Claim 25, the Examiner sets forth that the pop up window of Gilbert (additional visually perceivable advertising message information) is displayed in a region (window) adjacent to the selected subarea (frame). The Examiner directs the Applicants' attention to what the Examiner believes is the pop up window over (adjacent) the banner 26 in Fig. 26. The Examiner therefore sets forth that the pop up window does not have a button in the window for closing the window ("x"), and therefore it is believed by the Examiner to remain perceivable to the person as long as the cursor remains on the selected subarea (frame) or on the pop window and that it is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with

the mouse over. The Examiner sets forth that official notice is taken of this and the Applicants object to the Examiner's official notice as previously described. Therefore the Examiner believes that it would have been obvious to one of ordinary skill in the art to ensure the pop up window of Gilbert remains open as long as the cursor remains on the selected subarea (frame) or the pop up window (region), because the lack of movement of the cursor indicates the user is still reading the additional information.

With respect to Claims 26-27, the Examiner sets forth that the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable advertising message information (pop up) when in receipt of signals transmitted from a further web site in response to the instructions, and that the initial signals of Gilbert require re-accessing the further web site for selecting the transmitted signals. The Examiner directs the Applicants' attention to Col. 17, lines 25-31 and 50-54.

Referring to Claim 28, the Examiner sets forth that Gilbert discloses a method of enabling a user on a website to traverse a banner presented on the website to display an image (pop-up) in response to the traversing of the banner, and that the method of Gilbert provides the banner with a selected hot spot having an associated image (the Examiner directs the Applicants' attention to Col. 17, lines 45-47), activates the hot spot when an indicator (mouse) traverses the selected hot spot and enables the associated image (pop-up) when the traversed spot is activated to provide an enabled image (Col. 17, lines 44-47 on how a pop-up is displayed in response to a mouse, and the pop-up window over (adjacent) the banner 2600 in Fig. 26.

According to the Examiner, the pop-up window does not have a button in the window for closing the window ('x'), and therefore is believed by the Examiner to remain enabled as long as the indicator (mouse) is disposed on the pop-up (enabled image), and the pop-up is removed when the mouse is moved off of it. It is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner sets forth that Official Notice of this is taken. The Examiner believes it would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains over the enabled image (pop-up), because the lack of movement of the cursor indicates the user is still reading the additional information.

The Examiner sets forth that the instructions for controlling the display of Gilbert (i.e. the banner area with pop up windows) are provided through Java Applets, Col. 17, lines 12-30 and that the instructions are essentially compiled code, and the Examiner believes that compiled code may be achieved through a vast array of programming environments, including Java Applets, XML and JavaScript, for example.

Therefore, the Examiner sets forth that Gilbert implies but does not explicitly teach that Java Script may be used to provide the instructions in the method above. However, the Examiner believes that Wei explicitly teaches that Java Applets require starting the Java Virtual Machine and taking extra time to download (Col. 3, lines 29-39 and Col. 4, lines 14-25). According to the Examiner, Wei describes how JavaScript may replace Java Applets to increase performance and reduce the user's wait time (Col. 4, lines 30-54) and

that it would have been obvious to one of ordinary skill in the art to modify the advertising method of Gilbert such that the instructions for controlling the display to provide banner advertisements, and enabling and removing images associated with hot spots in the banner are written with JavaScript instead of Java Applets in order to increase performance and reduce wait time as suggested by Wei.

Referring to Claim 29, the Examiner sets forth that in the method of Gilbert, a further website is associated with the associated image (pop-up) and further comprises the step of clicking on the enable image and transporting the user to the further website in response to the clicking. The Examiner cites Col. 17, lines 48-64.

Referring to Claim 30, the Examiner sets forth that the banner in Gilbert is provided with a further hot spot and comprises the step of traversing the hot spot by the indicator (mouse) within the banner and enabling a further associated image (pop-up) in response thereto. According to the Examiner, Col. 17, lines 40-47, describe how the banner may be divided into frames, each having an associated pop-up on a mouse over.

Referring to Claim 31, the Examiner sets forth that the indicator of Gilbert is directed by a mouse and the user traverses the hot spot without clicking on the right or the left button of the mouse and cites Col. 17, lines 44-47, which the Examiner believes describe how a mouse over causes the pop-up to be displayed (the Examiner directs the Applicants' attention to activates the hot spot).

Referring to Claim 32, the Examiner sets forth that Gilbert discloses the step of altering associations between the hot spots (frames) and the associated images and

enabling the further associated image when the selected hot spot is traversed. The Examiner directs the Applicants' attention to Col. 17, lines 17-31 and 50-54, which the Examiner believes describe how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

With respect to Claim 33, the Examiner sets forth that the selected region (pop up placement) of Gilbert is disposed partially over the selected subarea. The Examiner directs the Applicants' attention to Fig. 26, 2600 which the Examiner believes shows the pop up is partially over the metal frame (selected sub area).

With respect to Claim 34, the Examiner sets forth that Gilbert shows a selected region disposed outside the selected subarea for displaying additional visually perceivable advertising message information. The Examiner directs the Applicants' attention to Fig. 26, 2606 which the Examiner believes provides information about the selected product in the selected region of the banner in a frame outside of the selected subarea.

The Examiner further sets forth that Claims 3-5 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,496,857 to Dustin, et al. (hereinafter Dustin). According to the Examiner, with respect to Claims 3-5 and 22-24, Gilbert discloses additional perceivable information in the form of a pop-up window, but does not explicitly describe that the pop-up window contains audio information, video information, or mixed media information. However, the Examiner believes that Dustin describes a method for enhancing advertisements, which provides ads that contain audio,

video, and/or mixed media information (the Examiner directs the Applicants' attention to Col. 3, lines 5-8). According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the pop-up window advertisement of Gilbert, such that they include audio, video, and/or mixed media information for a more effective form of advertisement as supported by Dustin.

The Examiner further sets forth that Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,401,075 to Mason, et al. (hereinafter Mason). According to the Examiner, with respect to Claims 16-18, Gilbert discloses that the advertisement may be customized according to a user profile or at the discretion of the advertiser (the Examiner directs the Applicants' attention to Col. 17, lines 21-31), but that Gilbert does not explicitly teach altering the associations between the sub-areas and the additional visually perceivable information in accordance with recorded performance parameters. However, the Examiner believes that Mason discloses methods of monitoring internet advertising, in which parameters (which are predetermined) representative of the advertisements (i.e. click-through) are recorded to provide recorded performance parameters, and the advertisements presented are altered in accordance with the recorded performance parameters (the Examiner directs the Applicants' attention to Col. 2, lines 39-51). According to the Examiner, altering the advertisements in accordance with the recorded performance parameters is repeated to provide the advertiser with accurate results of the success of the advertisement and it would have been obvious to one of ordinary skill in the art to modify the associations between the frames of the banner

(sub-areas) and the pop-up window (additional visually perceivable information) of Gilbert in accordance with recorded performance parameters as taught by Mason in order to provide the advertiser with information on the success or the advertisements in the pop-up window and alter the pop-up window and banner accordingly as supported by Mason.

The Examiner sets forth that Applicants' arguments filed June 28, 2004 have been fully considered but that they are not persuasive to the Examiner.

The Examiner further sets forth that Applicant requests that a reference be provided to support the Official notice teaching that it is conventional for a popup to remain visually perceivable as long as the cursor (mouse) remains over the image associated with the mouseover. According to the Examiner, the web page "Legend and Color Coding", http://www.ic.arizona.edu/~ame463/help_4.htm, which was posted January 17, 2000, as shown by the HotBot Search results page (Web Result 2.), describes how an image (i.e. Image A) pops up when the mouse pointer is placed over a particular image, and disappears when the mouse pointer is out of the particular image, and an example is provided on page 2, with the text, "The University of Arizona". Therefore, the Examiner believes that this web page supports the Official notice teaching.

The Examiner further sets forth that Applicant states that the execution of the Java instructions for permitting the performance of the operations of Gilbert requires the system upon which the applet is operating to invoke a Java Virtual Machine. According to the Examiner, it is the operation of Java Virtual Machine upon the applet that permits the precompiled instructions to be executed. The Examiner believes that Wei teaches starting

the Java Virtual Machine adds traffic to the network and increases wait time. The Examiner directs the Applicants' attention to col. 3, lines 36-39. The Examiner further believes that Wei suggests using JavaScript instead of Java Applets (i.e. col. 4, lines 37-40), and therefore provides proper motivation for one of ordinary skill in the art to replace the Java Applets of Gilbert with JavaScript.

The Examiner further sets forth that Applicant argues that the use of JavaScript speeds up the execution time in the claimed invention over the use of Java Applets and that practitioners skilled in the art would teach away from this conclusion. However, the Examiner believes that there is at least one instance of the teaching that JavaScript may speed up execution time in the prior art, because Wei teaches that JavaScript increases execution speed over Java Applets. Therefore, according to the Examiner, it would have been obvious to one of ordinary skill in the art with the references of Gilbert and Wei before him to implement the advertising method fo Gilbert in JavaScript rather than Java Applets for faster execution.

In response to Applicants' arguments that Wei is non-analogous art due to the larger size of applications in Wei, the Examiner sets forth that it has been held that a prior art reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. The Examiner directs the Applicants' attention to *In re Oetiker*, 977 F.2d 1443, 24USPQ2d 1443 (Fed. Cir. 1992).

In this case, according to the Examiner, both Gilbert and Wei are directed to providing web page information through the use of Java based programming.

Furthermore, the Examiner believes that Java Applets are described as one embodiment in Gilbert for providing the compiled code, and compiled code may clearly be provided through all kinds of programming environments. Therefore, the Examiner believes that while the method of Gilbert gives the example of Java Applets, one of ordinary skill in the art readily recognizes that other programming environments may be used to provide the instructions, especially other Java constructs (i.e. JavaScript, JSP, etc.) primarily used in the web programming filed of the banner advertising method of Gilbert. According to the Examiner, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art (i.e. interchanging Java Applets and JavaScript) cannot be the basis for patentability when the differences would otherwise be obvious. The Examiner directs the Applicants' attention to *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App & Inter. 1985).

Applicants' Response to Reference Provided by the Examiner in Support of Judicial Notice

The Examiner sets forth above that a web page entitled "Legend and Color and Coding" which was posted on January 17, 2000 describes how an image pops up when a mouse pointer is placed over a particular image, and disappears when the mouse pointer is out of the particular image. The Examiner believes that this web page is evidence supporting the Examiner's official notice.

The Applicants respectfully traverse the Examiner and submit that the combination of references suggested by the Examiner is impermissible because there is no suggestion to combine the references set forth within the references, that the official notice taken by the Examiner is impermissible in spite of the web page reference cited by the Examiner, and that the web page reference cited by the Examiner was posted less than one year before the Applicants' filing date. The Applicants believe that they can swear behind this reference and they are searching for satisfactory documentary evidence of an earlier invention date. It should be noted that the same is true with respect to the Gilbert and Wei references.

At the outset, the Applicants set forth that the rejection of Claims 1, 21 and 28 under 35 U.S.C. §103 as being unpatentable over Gilbert in view of Wei, with official notice taken of the "Legend and Color Web Page" (the "Web Page"), is improper because the required teaching, suggestion, or motivation to combine the Web Page with Gilbert or Wei is not present.

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

There are three possible sources for such a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of

persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

The Applicants submit that the Examiner's use of the Web Page effectively amounts to combining a third reference to produce the Applicants' claimed invention, since Gilbert and Wei do not teach or suggest the features that the Examiner sets forth are taught by the Web Page. Therefore, the Applicants submit that the Examiner must set forth such a suggestion to combine in order to be in complete compliance with the requirements of 35 USC §103. The obligation to comply with the suggestion to combine standards of 35 U.S.C. §103 cannot be avoided by citing one of the combined references as "Official Notice."

In support of this position, the Applicants cite a non-binding opinion of The Board of Patent Appeals and Interferences: Ex parte Wayne H. Deloreia, Appeal No. 1999-2130 which sets forth that art used as evidence in official notice must qualify as art under 35 USC §102. By implication, if such art is used as a reference under 35 U.S.C. §103, it must comply with the requirements thereof, including a suggestion to combine.

Furthermore, the Patent Office has provided "2002 Business Methods Summer Partnership Meeting Follow-Up Questions" on the Patent Office web page at http://www.uspto.gov/web/menu/pbmethod/summer 2002qanda which included several questions and answers on the practice of basing rejections upon official notice. The Patent Office set forth that an "Officially Noted" fact can be combined with a reference to reject a claim under 103 provided the facts so noticed are of a notorious character and serve only

to fill in the gaps which must exist in the evidentiary showing made by the Examiner to support a particular ground of rejection, in citing Damn v. Johnston.

With respect to the 35 U.S.C. §103 standards the Examiner must meet, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis added) In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem. See, In re Fine, 837 F.2d 1071, 1075-76, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); and Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988). The Examiner has failed to meet the standard set forth in the In re Fine and In re Diversitech Corp. v. Century Steps, Inc because the references cited, especially the Web Page, do not address or solve the problems addressed by Applicants' claimed invention..

The Applicants' invention addresses, inter alia, the problem of how to make windows of advertising message information pop up and then disappear substantially more quickly than had been provided by the prior art solutions. In the Applicants' field of art, i.e. advertising message information, pop ups must appear and disappear substantially more quickly that in the prior art. This requirement arises in the Applicants' field of art due to the strict requirements of an advertising environment, wherein the viewer's eyes will flick away

from the hot spot much more quickly than the eyes of viewers who are seeking the pop up information and are willing to wait for it. Thus, in the environment of the Applicants' invention, the pop up must appear almost instantly.

The Web Page does not address the problem solved by the Applicants' at all (i.e. immediate pop ups), since it operates in an environment wherein the normal amount of time is available for pop ups. Since the Web page merely teaches an image popping up in a conventional amount of time it does not address the problem of popping the image up immediately. The same is true of Gilbert and Wei.

Thus, the prior art solutions to the problem of providing and removing the pop ups taught by the Web Page do not address the problem solved by the Applicants' invention. Therefore the prior art cited by the Examiner does not meet the standards required by In re Fine and In re Diversitech Corp. v. Century Steps, Inc., that the problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem.

Furthermore, the cited art not only fails to address the problem solved by the Applicant, it actually teaches away from the Applicants' solution to the problem. It is well known that the use of precompiled code will usually speed up the execution of instructions since it eliminates the time needed for the compilation of uncompiled code at the time of execution. Thus, the Applicants' inventive contribution is in recognizing that the required operations would be substantially speeded up by eliminating the need to invoke the Java virtual machine, even though additional time would then be required to compile the

uncompiled code at the time of execution. The Applicants therefore obtained unexpected results.

The Applicants' method, which thus runs counter to the conventional wisdom in the field, has produced substantial improvements in speed. Using Applicants' method the speed for producing a visual display of content after navigation to the selected sub-area is well under a second, usually on the order of approximately .8 seconds, compared with several seconds using the prior art applet method. The improvement in speed provided thereby has thus met a long felt need in the field.

Additionally, the Applicants' method has met with considerable commercial success. The success was illustrated by the fact that the largest consumer of the services provided by the Applicants has, since the introduction of the Applicants' method, required all banners carried on its system to use this method in order to improve the overall system performance.

Additionally, the authorization located by the Applicants for the Examiner's use of the Official Notice in Title 37-Code of Federal Regulations Patents, Trademarks and Copyrights appears in Part 41 thereof, setting forth the rules of practice before the Board of Patent Appeals and Interferences, which handles quasi judicial ex parte procedures. However, even if the authorization to use Official Notice is extended from the context of interference proceedings, and applied to examination of patent applications the Examiner's use of Official Notice is still impermissible. 37 CFR §41.152(a) sets forth that the Federal Rules of Evidence shall apply to contested cases in the Patent Office. It is important to

note that 37 C.F.R. §41.152(c)(ii) equates official notice and judicial notice. Thus, the standard the Examiner must meet is the standard of judicial notice.

The Federal Rules of Evidence relating to the use of judicial notice are set forth in Fed.R.Evid. Section 201. Section 201 sets forth that judicial notice of facts is permitted when they are either "(1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."

Under the plain meaning of the foregoing words, the notice taken by the Examiner does not meet the standard. The Applicants believe and submit that the matter which the Examiner takes official notice of is not "generally known' or "capable of accurate and ready determination," and that the only support for it on the records is the single reference cited by the Examiner.

In order to further support the Applicants' interpretation of the foregoing standard for permissible use of official notice, the Examiner's attention is respectfully directed to the following. In order for a judicial notice to be proper, the facts noticed must not be subject to reasonable dispute, and they must be capable of ready determination. Fed.R.Evid. 201(a) The facts must be beyond reasonable controversy and must be a matter of common knowledge. 424 U.S. 917. If not the motion to take judicial notice must be denied. U.S. v. Decker 444 U.S. 855. There must be sufficient record of evidence to permit consultation. U.S. v Jones, 580 F 2nd 219. The specific facts and propositions must be of generalized knowledge which are capable of immediate and accurate determination by

resort to easily accessible sources of indisputable accuracy. Weaver vs. U.S., 298 Fed. 2d 496, Government of the Virgin Islands vs. Grereau, 523 F.2d 140.

Very significantly for the instant application, the more critical an issue is to a case the more reluctant the Courts should be to determine it by taking notice. TWA v. Hughes 405 U.S. 915. The Applicants respectfully submit that the criticality of the official notice issue in the instant case is high since it could be dispositive. Thus, the official notice taken by the Examiner is impermissible and should be withdrawn.

Applicants' Discussion of the Prior Art

Gilbert teaches projects which include a meta object layout and a number of meta objects, wherein meta layout contains the mapping information of the meta objects. The meta objects contain linked nodes of a hierarchal data structure and the mapping information is used for mapping the meta objects to the display. Queries taught by Gilbert retrieve projects, and thereby the meta objects within them, are adapted to return data as query results which are then passed to the display.

It is the problem of providing a virtually immediate display of associated advertising message information that the Applicants' invention has solved. The Applicants recognized that the time between (1) navigating to the selected sub-area of the banner, and (2) the display of the associated content, could be substantially reduced if Javascript is used to provide the instructions controlling the display rather than Java applets.

Furthermore, practitioners skilled in the relevant art would consider the prior art to teach away from this conclusion, since it is well known that the use of precompiled code

will usually speed up the execution of instructions because it eliminates the time needed for the compilation of uncompiled code at the time of execution.

With respect to this argument, the Examiner directs the Applicants' attention to col. 3, lines 36-39 and col. 4, lines 37-40 of Wei. The Examiner sets forth that Wei suggests using JavaScript instead of Java Applets (i.e.), and therefore provides proper motivation for one of ordinary skill in the art to replace the Java Applets of Gilbert with JavaScript.

Thus, the Applicants' contribution is in recognizing that the required operations would be substantially speeded up by eliminating the need to invoke the Java Virtual Machine, even though additional time would then be required to compile the uncompiled code at the time of execution.

The improvements in speed produced by the Applicants' method is substantial. Using Applicants' method the speed for producing a visual display of content after navigation to the selected sub-area is well under a second, usually on the order of approximately .8 seconds, compared with several seconds using the prior art applet method. The improvement in speed provided thereby has thus met a long felt need in the field.

Additionally, the Applicants' method has met with considerable commercial success. The success was well illustrated by the fact that the largest consumer of the services provided by the Applicants has, since the introduction of the Applicants' method, required all banners carried on its system to use this method in order to improve the overall system throughput.

Dustin teaches delivering targeted enhanced advertisements across electronic networks. In the system taught by Dustin equipment at the user site sends a notification when the user clicks on a specific portion of a displayed advertisement. In response to the clicking on the advertisement an enhanced version of the advertisement is accessed. At a later time, the user can request access to the enhanced information. In one embodiment of the system taught by Dustin a stream of thumbnails of enhanced versions of the information can be displayed on the user's screen. However, the thumbnails are transmitted in response to clicking on a specified designation within the banner, rather than in response to merely navigating to one of a plurality sub-areas in the banner. Selected thumbnails within the plurality of thumbnails can be enlarged by navigating to them. Dustin does not teach the user of Javascript to perform any of these operations.

Mason teaches a method for obtaining an advertisement, modifying the advertisement to fit designated spaces for differing web sites, and placing the differing advertisements at the differing web sites. In the method taught by Mason, an original advertisement is loaded into a central processor and used to form derivative advertisements that conform to the configuration parameters of a plurality of selected web sites. The properly configured derivative advertisements are then transmitted to their corresponding web sites. Parameters such as the number of hits or click through obtained by the advertisements are monitored. Mason does not teach the automatic provision of additional visually perceivable information corresponding to a selected sub-area when a

user positions the cursor on a sub-area whatsoever. Furthermore, Mason does not teach the use of Javascript to perform any of these operations.

The Applicants' invention is a method for delivering information to a person accessing a banner having a plurality of sub-areas. When the person positions a cursor on a selected sub-area additional visually perceivable information associated with the selected sub-area is displayed by means of Javascript. The additional visually perceivable information in the Applicants' system is advertising message information which must be displayed virtually immediately upon positioning the cursor on the sub-area of the banner, in order to obtain its maximum effect. It is the use of Javascript, rather than precompiled Java or applets, to create such a display that permits the required virtually immediate display of the associated information. The additional advertising message information that is displayed in this manner continues to be displayed as long as the cursor is positioned on the banner or on the additional information.

Applicants' Pending Claims

Therefore, the Applicants' amended Claim 1 sets forth a method for delivering information to a person accessing a banner web site from a terminal located remote from a source of the banner web site, the terminal having an associated display upon which content of the web site is visually perceived by the person using the terminal and a cursor whose position is controllable by the person. The method of Claim1 recites the step of providing initial signals from the source of the web site or from another remote source by means of Javascript when the web site is accessed by the person to establish a banner

area on the display, the banner area having banner boundaries and including (i) banner advertising message information that is visually perceivable by the person when the web site is accessed and (ii) plural sub-areas of the banner. Enabling the person to control the cursor and to position the cursor on any one of the sub-areas of the banner to provide a selected sub-area is also recited. When this occurs, the person is automatically provided by means of Javascript with respective additional visually perceivable advertising message information associated with the selected sub-area. The additional visually perceivable advertising message information is provided without requiring other action by the person and the additional visually perceivable advertising message information is displayed in a selected region of said display. Amended Claim 1 further sets forth enabling the person to control the cursor to position the cursor on the selected region and that the respective additional visually perceivable advertising message information is imperceivable by the person until the cursor is located on the selected sub-area and remains perceivable to the person as long as the cursor is positioned on the sub-area or the selected region.

Amended Claim 21 sets forth a method for delivering advertising messages to a person accessing a web site from a terminal located remote from the source of the web site, the terminal having an associated display upon which the content of the web site is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. The system includes means coupled to the source of the web site or to another remote source for providing initial signals from the source of the web site or from the other remote source when the web site is accessed by the user to establish a

banner area on the terminal by means of Javascript. The banner area includes banner advertising message information that is visually perceivable by the person when the web site is accessed and plural sub-areas of the banner area. The initial signals cause the terminal to provide respective additional visually perceivable advertising message information associated with a selected sub-area by means of Javascript, when the cursor is located over the selected sub-area. The additional visually perceivable advertising message information is provided by the terminal substantially outside the boundaries of the banner area and without requiring other action by the person. The respective additional visually perceivable advertising message information is imperceivable by the person until the cursor is located on the selected sub-area.

The Applicants' amended Claim 28 sets forth a method of enabling a user on a web site to traverse a banner presented on the web site using an indicator to display an image in response to the traversing of the banner. Amended Claim 28 recites the steps of providing the banner by means of Javascript wherein the banner has a first hot spot with an associated image of advertising message information and activating the first hot spot when the indicator traverses the first hot spot. Enabling the associated image of the first hot spot by means of Javascript when the first hot spot is activated to provide an enabled image is also set forth. The indicator is moved to the enabled image and the enabled image is retained while the indicator is disposed on the enabled image and the enabled image is removed by means of Javascript when the indicator is moved off the enabled image.

Patentability Arguments

Gilbert does not teach or suggest providing by means of Javascript additional visually perceivable advertising message information as set forth in the Applicants' amended independent Claims 1, 21 and 28. Rather, Gilbert teaches the use of applets, which are known to include precompiled Java instructions rather than Javascript to perform the operations of providing banners and pop-ups which are not advertising message information. This teaching in Gilbert does not teach or suggest the Applicants' novel use of Javascript to solve the problem of immediately displaying advertising message information. Conversely, the Applicants' solution to the problem of speeding up the display of the advertising message information using Javascript is taught away from by the prior art in the field. It is well known that the prior art suggests that the use of uncompiled code would be slower rather than faster due to the fact that the uncompiled code would have to be compiled at the time the instructions are executed. There is no suggestion in Gilbert or the other known prior art that eliminating the calling up of the Virtual Machine required to execute the precompiled code speed up the process rather than slow it down. Therefore, Gilbert does not teach performing the claimed operations by means of Javascript as set forth in the Applicants' amended Claims 1, 21 and 28.

Wei teaches a computer architecture called Thin Client Computing. In Thin Client Computing the application programs are run on a server, while the Thin Client acts only as a user interface at the client end. The user's input, such as keyboard strokes/mouse movements, originate at the client machine and are transmitted to the server via the

network. The server's application program processes these transmitted events and sends the output back to the client machine.

The program executed at the client end in the system taught by Wei is intended to be a full featured Graphical User Interface (GUI). The GUI allows the client to have a virtual interface to the application program which is running on the server rather than on the client by replacing the client program with the downloaded GUI. Typical sizes of GUI's in this type of system are 30K to 40K.

Thus, it should be noted that Wei's solution of using JavaScript rather than Java Applets is applied to substantially large programs. For example, in the system taught by Wei in Col. 4, lines 51-54, the client program takes four seconds to download, even after being sped up by a factor of ten to twenty times. It is very well known in the art to use JavaScript rather than Java Applets for programs of this size. However, the Applicants claimed invention sets forth that it is advertising message information that is provided by the JavaScript. It is well known in the art that the routines used for providing such advertising message information can be at least an order of magnitude smaller than the ones to which the teachings of Wei are applied.

For example, routines that provide the Applicants' advertising message information are typically 6-8 kilobytes, compared with the typical program in the system taught by Wei which are typically 30K to 40K as previously described. Thus, a teaching that shows compiling code and eliminating the loading of the Java Virtual Machine are suitable for the

applications of Wei, does not suggest that it would be suitable for a system that provides advertising message information, as claimed by the Applicants.

Therefore, Wei's teaching of applying this solution to substantially larger programs does not suggest that the substitution of JavaScript for Java Applets would work for substantially smaller applications such as those in the Applicants invention. It was the Applicants invention to recognize that this was the case.

Dustin does not teach or suggest providing initial signals by means of Javascript, providing additional visually perceivable advertising message information by means of Javascript establishing a banner area on a terminal by means of Javascript, or removing an enabled image by means of Javascript. Rather, Dustin is silent with respect to the use of precompiled Java instructions or Javascript to perform the operations of providing banners and pop-up. Therefore, Dustin does not teach performing the claimed operations by means of Javascript as set forth in the Applicants' amended Claims 1, 21 and 28.

Mason does not teach or suggest providing initial signals by means of Javascript, providing additional visually perceivable advertising message information by means of Javascript establishing a banner area on a terminal by means of Javascript, or removing an enabled image by means of Javascript. Rather, Mason is silent with respect to the use of precompiled Java instructions or Javascript to perform the operations of providing banners and pop-ups. Therefore, Mason does not teach performing the claimed operations by means of Javascript as set forth in the Applicants' amended Claims 1, 21 and 28.

Thus, none of the references cited by the Examiner teaches or suggests the use of Javascript to perform the operations set forth in the Applicants' amended Claims 1, 21 and 28. Furthermore, no combination of the references teaches or suggests this inventive feature. All of the remaining claims depend from one of the foregoing independent claims, and are patentable for the same reasons.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
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Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.